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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,092	09/05/2003	Peter Albany	2024738/7034342001	9925
7590 10/25/2005			EXAMINER	
Bingham McCutchen LLP			LEE, SEUNG H	
Suite 1800			ART UNIT	
Three Embarcadero Center			PAPER NUMBER	
San Francisco, CA 94111-4067			2876	

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

**Office Action Summary**

Application No.

10/656,092

Applicant(s)

ALBANY, PETER

Examiner

Seung H. Lee

Art Unit

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11-15,17,18 and 20 is/are rejected.
- 7) ☒ Claim(s) 16,19 and 21-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Receipt is acknowledged of the response filed on 10 August 2005, which has been entered in the file.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-5, 8, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kallioniemi et al. (US 6,905,823)(hereinafter referred to as 'Kallioniemi') in view of Abram (WO 02/21425 A2, of record).

Kallioniemi teaches a slide (78) serving as a cytological specimen carrier for carrying tissues wherein the slide also comprises a darkened edge (80) for labeling related to cellular analysis of cytological specimen (figs. 1-17; col. 6, line 9- col. 8, line 65; col. 33, lines 48- col. 34, line 5).

However, Kallioniemi fails to teach or fairly suggest that the slide comprises data storage.

Abrams teaches a disposable specimen container such as a vial for obtaining the patient urine or blood specimen and the read/write data storage device such as a RFID device is attached to the specimen vial, the RDIF also storing individual of identification

that is related to analysis of the cytological specimen wherein the container can be any formed in a variety of bodies (see page 2, lines 14-26; page 4, lines 2-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Abrams to the teachings of Kallioniemi in order to provide a user friendly system wherein a user/operator can identify and track the carrier wirelessly using RFID tag attached thereon.

4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kallioniemi in view of Abrams as applied to claim 1 above, and further in view of Weissman (US 5,561,556, of record)

The teachings of Kallioniemi/Abrams have been discussed above.

Although, Kallioniemi/Abrams teaches the specimen container having the storage device such as the RFID device attached to the container, he fails to particularly teach or fairly suggest that the specimen is a slide and the data storage device is a magnetic or optical storage device.

However, Weissman teaches a microscope slide (1) for containing specimen (2) wherein the slide comprises a magnetic stripe (6a) or optically read/writable stripe (6b) (see figs. 1a and 1b; col. 4, lines 7-51; col. 5, line 56- col. 6, line 39)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Weissman to the teachings of Kallioniemi/Abrams in order to provide an alternative device to store data regarding specimen into the magnetic stripe or optical stripe instead of the RFID device in which

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also reduce cost of operating of analyzing of specimen due to the cheaper price of the storage medium (e.g., a magnetic or optical stripe) and reader/writer capable of writing/reading data to/from the magnetic or optical stripe compare to that of the RFID device.

5. Claims 9-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kallioniemi in view of Abram and Ellis et al. (US 6,631,203)(hereinafter referred to as 'Ellis').

Kallioniemi teaches a slide (78) serving as a cytological specimen carrier for carrying tissues wherein the slide also comprises a darkened edge (80) for labeling related to cellular analysis of cytological specimen (figs. 1-17; col. 6, line 9- col. 8, line 65; col. 33, lines 48- col. 34, line 5).

However, Kallioniemi fails to teach or fairly suggest that the slide comprises data storage.

Abrams teaches a disposable specimen container such as a vial for obtaining the patient urine or blood specimen and the read/write data storage device such as a RFID device is attached to the specimen vial, the RDIF also storing individual of identification hat is related to analysis of the cytological specimen wherein the container can be any formed in a variety of bodies (see page 2, lines 14-26; page 4, lines 2-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Abrams to the teachings of

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Kallioniemi in order to provide a user friendly system wherein a user/operator can identify and track the carrier wirelessly using RFID tag attached thereon.

However, they fail to particularly teach or fairly suggest that the system comprises an imaging device, a processor, and a microscope.

Ellis teaches an automated image analysis system comprising a CCD camera (42) for capturing images of slide carrier having a biological specimen (60), a computer (22) having processors (e.g., a system processor (23) and a imaging processor (25)) for analyzing images of the specimen such as area of interests (e.g., color, size, and shape) and location of interests area (e.g., X-Y stage of interest area), and a viewing oculars (20) of the microscope subsystem for operator viewing (see Figs. 1-10; col. 1, lines 36—col. 2, line 3; col. 8, line 59-col. 12, 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Ellis to the teachings of Kallioniemi/Abrams in order to provide an automated analyzing system by capturing the images of specimen and storing values of area of interests using the computer for also providing convenience retrieval of data regarding specimen by a pathologist or cytotechnologist. Moreover, such modification (e.g., an automated analyzing system comprising a viewing oculars) would provide an instant access to operator of the automated analyzing system.

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6. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kallioniemi modified by Abrams and Ellis as applied to claim 9 above, and further in view of Weissman (US 5,561,556, of record)

The teachings of Kallioniemi/Abrams/Ellis have been discussed above.

Although, Kallioniemi/Abrams/Ellis teaches the specimen container having the storage device such as the RFID device attached to the container, he fails to particularly teach or fairly suggest that the specimen is a slide and the data storage device is a magnetic or optical storage device.

However, Weissman teaches a microscope slide (1) for containing specimen (2) wherein the slide comprises a magnetic stripe (6a) or optically read/writable stripe (6b) (see figs. 1a and 1b; col. 4, lines 7-51; col. 5, line 56- col. 6, line 39)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Weissman to the teachings of Kallioniemi/Abrams/Ellis in order to provide an alternative device to store data regarding specimen into the magnetic stripe or optical stripe instead of the RFID device in which also reduce cost of operating of analyzing of specimen due to the cheaper price of the storage medium (e.g., a magnetic or optical stripe) and reader/writer capable of writing/reading data to/from the magnetic or optical stripe compare to that of the RFID device.

***Allowable Subject Matter***

7. Claims 16, 19, and 21-24 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

Although, Kallioniemi/Abrams/Ellis/Weissman teaches the specimen carrier such as slide having the data storage device attached to the slide wherein the data storage device is a magnetic or optical storage device. However, Kallioniemi/Abrams/Ellis/Weissman fails to particularly teach or fairly suggest that the data storage of the cytological specimen comprising slide coordinates of location of identified objects in the cytological specimen and data related to the analysis of the cytological specimen is cellular analysis data as set forth in the claims.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

In response to the applicant's argument that "...Applicant note that "cytological" is defined as "of or relating to the science of cytology" and that "cytology" is defined as "



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the branch of biology that deals with the formation, structure and function of cells"....These definition are consistent with use of "cytological" in the subject application, and the related data that is obtained from analyzing cells or groups of cytological specimen" ( see page 6, line 24+), the Examiner respectfully provide Kallioniemi reference wherein Kallioniemi discloses cytological specimen as discussed in paragraph 3 above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Pressman (US 6,535,626) discloses a specimen preview and inspection system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seung H. Lee whose telephone number is (571) 272-2401. The examiner can normally be reached on Monday-Friday, 7:30 AM- 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Seung H Lee  
Art Unit 2876  
October 20, 2005

  
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